



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/064,057	04/22/98	GERARD	G 0942.4330002

HM31/1221
STERNE KESSLER GOLDSTEIN & FOX
1100 NEW YORK AVENUE NW
SUITE 600
WASHINGTON DC 20005-3934

EXAMINER	
WHISENANT, E	
ART UNIT	PAPER NUMBER
1634	6

DATE MAILED: 12/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/064,057

Applicant(s)
Gerard et al.

Examiner
Ethan Whisenant

Group Art Unit
1634



☒ Responsive to communication(s) filed on 13 JUL 98 and 23 JUL 98

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5, 8, 10, 12-16, 18, 20, 21-23, 26, 28, 33-39, 37, 39-41, 43, 46, 51-57, 61-66, 68, 71, 76, 81-85, 87, 88-90, 97-102, 103-110, 112 and 114-116 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ ~~Claims~~ all of the above claims are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

ELECTION/RESTRICTION

- 1.** Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-5, 8, 22-23, 41, 43, 81-85, 87-88 and 116** drawn to a composition/ kit for use in reverse transcription of a nucleic acid molecule, which composition comprises two or more polypeptides having reverse transcriptase activity, classified in Class 530, subclass 350.
 - II. **Claims 10, 12, 15-16, 57, 61-63, 71, 89-90, 97-102 and 108** drawn to a method for the reverse transcription/ amplification of one or more nucleic acid molecules, classified in Class 435, subclasses 6, and 91.2.
 - III. **Claims 13-14, 18, 20, 64-65, 66, 68, 109-110, 112, and 114-115** drawn to a cDNA molecule, a vector comprising the cDNA molecule, as well as, a host cell comprising the cDNA molecule, classified in Class 536, subclass 23.1.
 - IV. **Claims 21 and 76** drawn to methods for sequencing one or more nucleic acid molecules, classified in Class 435, subclasses 6.
 - V. **Claims 26, 28, 33-34, 37, 39, and 40** drawn to a method for producing an ASLV reverse transcriptase, classified in Class 435, subclass 68.1 and 69.1.
 - VI. **Claims 46, and 51-56,** drawn to an isolated nucleic acid molecule comprising a nucleotide sequence which encodes one or more subunits of an ASLV reverse transcriptase, classified in Class 536, subclass 23.1 and Class 435, subclass 68.1 and 69.1.

2. The following explains why the groups above are patentably distinct inventions.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, for example the components of the product (i.e. the polypeptides contained in the kit/composition) can be used as molecular weight markers in protein gel electrophoresis.

Inventions I and III are drawn to two independent and distinct products which have different structural features.

Inventions I and IV are related as product and a process. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case both are true, the product as claimed can be used in a materially different process of using that product, and the process as claimed can be practiced with another materially different product, example the components of the product (i.e. the polypeptides contained in the kit/composition) can be used as molecular weight markers in protein gel electrophoresis. A process completely distinct from nucleic acid sequencing.

Inventions I and V are related as product and a process. The invention of group I is distinct from the invention of group V, because the process as claimed can be practiced with another materially different product.

Inventions I and VI are drawn to two independent and distinct products which have different structural features.

Inventions II and III are related as a process and product. The product in this case (Invention III), can be made by the process of Invention II, however, it does not have to be made by the process of Invention II but rather can be made by a materially different process.

Inventions II and IV are drawn to two independent and distinct methods which have different intermediate steps and different end results.

Inventions II and V are drawn to two independent and distinct methods which have different intermediate steps and different end results.

Inventions II and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, for instance, the product can be made by an automated DNA synthesizer.

Inventions III and IV are related as product and a process. The invention of group III is distinct from the invention of group IV, because the process as claimed can be practiced with another materially different product.

Inventions III and V are related as product and a process. The invention of group III is distinct from the invention of group V, because the process as claimed can be practiced with another materially different product.

Inventions III and VI are drawn to two independent and distinct products which have different structural features.

Inventions IV and V are drawn to two independent and distinct methods which have different intermediate steps and different end results.

Inventions IV and VI are related as a process and a product. The invention of group IV is distinct from the invention of group VI, because the process as claimed can be practiced with another materially different product.

Inventions V and VI are related as process of making and a product. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, for instance, the product can be made by an automated DNA synthesizer.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Brian Del Buono on 16 DEC 98 to request an oral election to the above restriction requirement, but did not result in an election.

The applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Group is (703) 305-3014. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.

ECW

Ethan Whisenant, Ph.D.
Patent Examiner

[Signature]
W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600

12/19/98